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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,208	07/15/2003	Jose Agerico R. Moncada	3409-140	1085
22204	7590	09/27/2005	EXAMINER	
NIXON PEABODY, LLP 401 9TH STREET, NW SUITE 900 WASHINGTON, DC 20004-2128			MAI, ANH T	
			ART UNIT	PAPER NUMBER
			2832	

DATE MAILED: 09/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,208

Applicant(s)

MONCADA ET AL.

Examiner

Anh T. Mai

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 August 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-9,11 and 12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7,11 and 12 is/are rejected.
- 7) ☒ Claim(s) 8 and 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. <u>8/9/05</u> . |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____. | 6) <input type="checkbox"/> Other: _____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-3, 5, 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Marth [4704592].

Marth discloses magnetic core having central elongated portion 1, the elongated portion having approximately rectangular cross-sectional shape, a winding 4 wound around the winding portion formed of two end portions 2 to be surface mounted on other structure; outer surface of winding defines a substantially rectangular planar surface to facilitate surface-mount of the winding such that substantially rectangular planar surface is coplanar with the end portion planar surface; a mounting frame 8 to secure wire ends 6 of the winding and to enable said core 1 and winding 4 to be surface mounted on a PCB [figure 1; abstract].

Limitation "to enhance heat transfer to said adjacent structure from the inductive device" is considered functional recitation. Marth has all structural limitations of the claim, therefore inherently can perform the heat transfer enhancement as claimed by the applicant.

A claim containing a "recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus" if the prior art apparatus teaches all the structural limitations of the claim. Ex

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parte Masham, 2 USPQ2d 1647 (Bd. Pat. App. & Inter. 1987; In re Danley, 120 USPQ 528, 531

(CCPA 1959).

The core portion 1 is formed with a winding space which is recessed relative to its one parallel end faces 2, and which in the embodiment shown carries a single-course winding 4. The front faces of both front ends 2, 2 have marginally open cutouts 3, 3 parallel to each other and extending over the entire narrow or broad side of the front faces.

Into these cutouts, tab-like contact elements 5 are inserted, which for easier insertion are beveled on one of their corner edges 7. Each of the contact elements 5 has a U-shaped portion 8, protruding out from the end faces 2, 2 and intended for tying the winding ends 6.

(5) The contact elements 5 may be glued into the cutouts 3 or may be retained in the cutouts by spring action by an appropriate selection of the size of their parts guided in the cutouts. ... The member 8 of the contact elements 5 brought out of the insulation material sheath 11 may be formed e.g. as plug pins suitable for insertion into pre-drilled circuit boards.

With respect to claim 3, member 8 of contact element 5 maybe formed plug pins suitable for insertion into pre-drilled circuit board [col 3, lines 32-50].

With respect to claim 5, the winding is wound along approximately the entire length of the elongated portion of the core [figure 1].

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marth in view of Lindqvist.

Marth discloses magnetic core having central elongated portion 1, the elongated portion having approximately rectangular cross-sectional shape, a winding 4 wound around the winding portion formed of two end portions 2 to be surface mounted on other structure; outer

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surface of winding defines a substantially rectangular planar surface to facilitate surface-mount of the winding such that substantially rectangular planar surface is coplanar with the end portion planar surface; a mounting frame 8 to secure wire ends 6 of the winding and to enable said core 1 and winding 4 to be surface mounted on a PCB [figure 1; abstract].

Marth discloses the invention as claimed as cited above except for a second magnetic core with the same structure of the first core. Lindqvist discloses a multiple magnetic core device wherein two elongated portions of the cores are placed in parallel so the ends of each core against each other as seen in figures 2a-c. At the time of the invention, it would have been obvious to a person of ordinary skill in the art to have additional core as taught by Lindqvist to Marth. The motivation would have been to provide variation of the embodiment of the devices. Therefore, it would have been obvious to combine Lindqvist with Marth.

In this case, two magnet cores 1 and respective coils 6 can be fabricated in accordance with the foregoing. The common yoke 10 will have a different configuration than that in the first embodiment, but will be made of the same material. In this case, the yoke 10 has an oval configuration and is comprised of strip material whose width is equal to the width of the strip material used to wind the cylinder 2. The yoke 10 is then wound with strip material disposed edge-to-edge with the outer ends 8, 9.

With respect to claims 11-12, the claims are method counterpart of structure claims 6-7.

Allowable Subject Matter

5. Claims 8-9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 8 recites, inter alia, *a mounting frame surrounding said first and second cores, wherein said mounting frame secures the wire ends of each said winding and enables said first and second cores to be surface mounted on adjacent structure.*

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Response to Arguments

6. Applicant's arguments with respect to claims 1-3, 5-9 and 11-2 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Muckelroy et al. [3585553]; Fan [6680664]; Simon [3745500].

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anh T. Mai whose telephone number is 571-272-1995. The examiner can normally be reached on 5/4/9 Schedule.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Elvin Enad can be reached on 571-272-1990. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**ANH MAI
PRIMARY EXAMINER**